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USPTO FACSIMILE TRANSMITTAL SHEET

Page 1 of 7

Docket No.: ORAL.001A

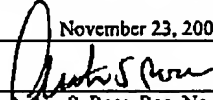
CUSTOMER NO. 20995

Applicant : Jerry W. Browning, et al.
App. No. : 10/800,144
Filed : March 12, 2004
For : DISPOSABLE DENTAL INSTRUMENT
Examiner : Todd E. Manahan
Group Art Unit : 3732

CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this correspondence and all marked attachments are being transmitted via facsimile to the USPTO Central Fax No. (571) 273-8300 on the date shown below:

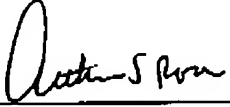
November 23, 2005


Arthur S. Rose, Reg. No. 28,038

Transmitted herewith for filing and consideration in the above-referenced application are the following items:

- (X) Notification of Corresponding PCT Filing and Request to Rescind Previous Nonpublication Request 35 U.S.C. § 122(b)(2)(B)(ii)

The Commissioner is hereby authorized to charge any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 11-1410.


Arthur S. Rose
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Page 1 of 3

From: Polutta, Mark [mailto:Mark.Polutta@USPTO.GOV]
Sent: Thursday, September 08, 2005 12:49 PM
To: DPhipps@kmob.com
Cc: Patent Practice; Chang, Joni
Subject: RE: Rescinding Nonpublication Request

Yes, that section of the MPEP does apply. No, the application will not be considered as abandoned for failure to notify the Office of the foreign filing within 45 days.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
(571) 272-7709

-----Original Message-----

From: Patent Practice
Sent: Wednesday, September 07, 2005 9:59 AM
To: Polutta, Mark; Chang, Joni
Subject: FW: Rescinding Nonpublication Request

Would one of you care to answer this one?

-----Original Message-----

From: Daima.Phipps [mailto:DPhipps@kmob.com]
Sent: Tuesday, September 06, 2005 4:01 PM
To: Patent Practice
Subject: RE: Rescinding Nonpublication Request

Thank you.

I have a follow up question. If the US and the PCT applications were filed on the same day will the US application still be regarded as abandoned because the nonpublication request was not rescinded within forty five days? The reason for this follow up question is that the following language quoted from MPEP 1122 relating to earlier filed PCT applications seemed as though it might logically apply to US and PCT applications filed on the same day.

11/23/2005

Where a foreign or PCT application is filed first, and a U.S. application is filed thereafter with an (improper) nonpublication request, the Office will not consider the U.S. application as abandoned for having made the nonpublication request. This is because the statute only provides for an application to be regarded as abandoned when the applicant fails to notify the Office within 45 days of a subsequently filed application that is directed to the same subject as the invention of the U.S. application in another country, or under a multilateral international agreement, that requires eighteen-month publication of applications. 35 U.S.C. 122(b)(2)(B)(iii) does not apply to the situation where the applicant has made an improper certification subsequent to the foreign filing. A petition to revive under 37 CFR 1.137(b)/(f) is inappropriate and not necessary in the above-noted situation because the U.S. application is pending (unless the application is abandoned for other reasons). If a petition to revive under 37 CFR 1.137(b)/(f) is filed, the Office will dismiss the petition as inappropriate but retain the petition fee because the Office was required to evaluate the merits of the petition before being able to determine that the petition was not appropriate.

Applicants and their representatives should make sure that the certification is proper before signing and filing it with the Office. While applicants should rescind any improper nonpublication request as soon as possible, 35 U.S.C. 122(b)(2)(B)(i)-(iv) does not include any provision for "correction" of an improper certification. Any applicant or applicant's representative who makes a false statement (e.g., an improper certification) may be in violation of 37 CFR 10.18(b). In addition, false statements by registered patent practitioners may also violate other Disciplinary Rules (see 37 CFR Part 10).

While applicant cannot undo the fact that an improper certification was made, any applicant who has made such a mistake should promptly file a rescission of the nonpublication request and note that the original certification was improper.

Dalima Phipps
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From: Patent Practice [mailto:PatentPractice@USPTO.GOV]
Sent: Friday, September 02, 2005 3:06 PM
To: Dalima.Phipps
Subject: RE: Rescinding Nonpublication Request

Thank you for your email.

Yes, a PCT application is an application that is filed multilateral international agreement requiring publication at 18 months. An applicant's failure to rescind a nonpublication request and notify the Office of foreign filing within 45 days of filing the foreign application results in the application being regarded as abandoned by operation of law. The application may be revived by way of petition.

The Office has a page of questions and answers relating to Eighteen-Month Publication of Applications. Here is a link:

<http://www.uspto.gov/web/offices/dcom/olia/aipa/18monthfaq.htm#caf>

-----Original Message-----

From: Dalima.Phipps [mailto:DPhipps@kmob.com]
Sent: Friday, September 02, 2005 2:43 PM
To: Patent Practice
Cc: Zasz
Subject: Rescinding Nonpublication Request

11/23/2005

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11/23/2005 16:24 FAX

Afternoon. For the purpose of rescinding a nonpublication request, is a PCT application considered a filing under a "multilateral international agreement" as described in 37 CFR 1.213(c)? If so, are there any remedies for an inadvertent failure to rescind the nonpublication request within 45 days of filing the PCT application?

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